

REMARKS/ARGUMENTS

Claims 1-20 are pending in this application. Claims 1-20 stand rejected. Claims 14-20 have been amended to clarify the claimed subject matter. No new matter has been added. In view of the following remarks, reconsideration and allowance of all pending claims are respectfully requested.

The Drawings

The drawings of the instant application were objected to because certain reference designators in the drawings were not mentioned in the description. Applicants have redacted the unmentioned reference designators from the drawings and submit replacement drawings herewith. Applicants believe the objection to the drawings should be removed.

Specification

The specification of the instant application was objected to because of certain reference designators in the drawings that were not mentioned in the description. Applicants have redacted the unmentioned reference designators from the drawings. Applicants believe the objection to the specification should be removed.

Claim Rejections under 35 U.S.C. § 101

The Office Action rejected claims 1-3, 5-10, 14 and 20 under 35 USC § 101 because the claimed invention is directed to non-statutory subject matter. The Office Action also states that there is no functional relationship imparted by the data (the claimed computer-executable

components) to a computing device and that the claimed invention describes software per se recorded on memory.

Applicants respectfully traverse the rejections. Beauregard-type claims are clearly patentable subject matter. Examination guidelines for patentable subject matter describe “functional descriptive material” consisting of data structures and computer programs which impart functionality when employed as a computer component. In determining whether the claim is for a “practical application,” the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result is “useful, tangible and concrete.”

Generally, it is appreciated that users often record software per se on computer-readable media because the software provides results that are useful, tangible and concrete. More specifically, one such possible result is accomplished by providing self-describing properties such as styles, fonts, list types, and the like. If such a portion of a document is subsequently copied or moved to a second document or to a different location in the first document, the self-describing properties provided for the portion travel with the portion to the second document or to the different location in the first document. Maintaining the formatting of the selected portions aids the ease in which the user can manipulate the copied portion, which thus provides useful, tangible, and concrete results.

The Office Action asserts, for example, that the claimed invention fails to describe a significant functionality for the processed portion of text. The cited portion of the claim misses the point. The applied XML markup (which is itself functional and can be applied to “non-

functional descriptive material” such as text) provides significant functionality in that it maintains the formatting context present in the first document for the benefit of the user making the selection. The formatting is maintained with the copied portion, which makes it easier for the user to immediately (and at later times) recognize (and otherwise intellectually grasp) the information of the copied portion because of the formatting functionality which retains the formatting of the original version. Notwithstanding the above, applicants have amended the claims to more clearly specify claimed subject matter.

Claim Rejections under 35 U.S.C. § 102(e)

The Office Action rejected claims 1-4, 10, 11, 13-15 and 20 under 35 USC § 102(b) as being anticipated by U.S. Patent Application No. 2004/0019853, filed 7/17/2003 (“Takizawa”). With regard to claim 1, Takizawa fails to teach or suggest applying XML markup to the selection of text for designating that the selection of text is formatted according to the data apart from any data applied to other portions of text in the first document or any subsequent document into which the selection of text is inserted.

In contrast, Takizawa teaches two formats: an XML format and an HTML format (see Abstract). A data conversion function portion converts XML format data into the HTML format data (see Abstract). The cited art (which is apparently a translation of Japanese into English) uses the term “format” to mean the type of markup language used to describe the data (and does not mean how the text itself is formatted. For example, the cited art teaches away from formatting selected text because “the data of the XML format is a simple text [sic] which does not have style definition [sic]” (paragraph 0088). Instead, styles are imposed, for example, using

CSS (cascading style sheets) and XSL, which transform the entire document (see paragraph 210), and thus do not format data according to the data apart from any data applied to other portions of text in the first document or any subsequent document into which the selection of text is inserted. Claim 1 is allowable.

Regarding claim 2, the cited art fails to teach or suggest applying XML markup to the selection of text for designating that the selection of text is formatted according to the data apart from any data applied to other portions of text in the first document or any subsequent document into which the selection of text is inserted as discussed above. Moreover, the cited art merely teaches viewing data that has been transformed from XML format to HTML format (paragraph 112). The viewed data can be reordered by selecting and moving graphical pins (see Fig. 7A). The editor saves the information (e.g., the reordered data) using the XML format (paragraph 113). Thus, the second document is not parsed for data required for the second document after inserting the selection of text into the second document. Claim 2 is allowable.

Regarding claim 3, the cited art fails to teach or suggest applying XML markup to the selection of text for designating that the selection of text is formatted according to the data apart from any data applied to other portions of text in the first document or any subsequent document into which the selection of text is inserted as discussed above. The prior art merely teaches a selection operation that is a menu selection of a document to be filed (paragraph 100). The transfer of data in XML format occurs in response to the selection of the menu item, rather than upon encountering XML markup. Claim 3 is allowable.

Regarding claim 4, the cited art fails to teach or suggest applying XML markup to the selection of text for designating that the selection of text is formatted according to the data apart from any data applied to other portions of text in the first document or any subsequent document into which the selection of text is inserted as discussed above. The prior art merely transforms XML into HTML using XSLT and/or CSS that apply to the entire document. Claim 4 is allowable.

Regarding claim 10, the cited art fails to teach or suggest applying XML markup to the selection of text for designating that the selection of text is formatted according to the data apart from any data applied to other portions of text in the first document or any subsequent document into which the selection of text is inserted as discussed above. The prior art merely transforms XML into HTML using XSLT and/or CSS that apply to the entire document. Claim 10 is allowable.

Regarding claim 11, the cited art fails to teach or suggest applying an XML tag to the selection of text whereby the XML tag may be recognized by an XML parsing application as designating that the selection of text is formatted according to the particular formatting data apart from any formatting applied to other portions of text. Instead, the cited art teaches away from formatting selected text because “the data of the XML format is a simple text [sic] which does not have style definition [sic]” (paragraph 0088). Styles are imposed, for example, using CSS and XSL, which transform the entire document (see paragraph 210), and thus do not format text according to the data apart from any formatting applied to other portions of text. Claim 11 is allowable.

Regarding claim 13, the cited art fails to teach or suggest applying an XML tag to the selection of text whereby the XML tag may be recognized by an XML parsing application as designating that the selection of text is formatted according to the particular formatting data apart from any formatting applied to other portions of text as discussed above. Claim 13 is allowable.

Regarding claim 14, the cited art fails to teach or suggest applying XML markup to the selection of text for designating that the selection of text is formatted according to the formatting data apart from any formatting applied to other portions of text in the first document or any subsequent document into which the selection of text is inserted. Instead, the cited art teaches away from formatting selected text because “the data of the XML format is a simple text [sic] which does not have style definition [sic]” (paragraph 0088). Styles are imposed, for example, using CSS and XSL, which transform the entire document (see paragraph 210), and thus do not format text according to the data apart from any data applied to other portions of text in the first document or any subsequent document into which the selection of text is inserted. Claim 14 is allowable.

Regarding claim 15, the cited art fails to teach or suggest applying XML markup to the selection of text for designating that the selection of text is formatted according to the formatting data apart from any formatting applied to other portions of text in the first document or any subsequent document into which the selection of text is inserted as discussed above. Claim 15 is allowable.

Regarding claim 12, the cited art fails to teach or suggest applying an XML tag to the selection of text whereby the XML tag may be recognized by an XML parsing application as

designating that the selection of text is formatted according to the particular formatting data apart from any formatting applied to other portions of text as discussed above. Claim 12 is allowable.

Claim Rejections under 35 U.S.C. § 103(a)

The Office Action rejected claims 5-9, 12 and 16-19 under 35 USC § 102(b) as being unpatentable over U.S. Patent Application No. 2004/0019853, filed 7/17/2003 ("Takizawa"). With regard to claim 5, Takizawa fails to teach parsing the second document (as discussed above, the second document is instead generated from the first document). The assertions of the Office Action fail to overcome this deficiency because Takizawa teaches away from applying an XSLT, for example, to the first document, which is parsed to produce the second document. In Takizawa, there is no need to parse the second document because the first document has already been parsed (for the purpose of producing the second document). Indeed, such duplicate parsing would be inefficient and not practiced by one of ordinary skill in the art to which the invention pertains at the time of the invention. Such an artisan would preserve the XML parse tree results by, for example, producing a document object model (DOM) as taught by Takizawa in paragraph 0088. Accordingly, there is no motivation or suggestion, except from the applicants' own disclosure, to make such a modification. Claim 5 is allowable.

With regard to claim 6, Takizawa fails to disclose the second document as XML. The assertions of the Office Action fail to overcome these deficiencies. The assertions of the Office Action fail to overcome these deficiencies because Takizawa teaches applying an XSLT to the first document (which is in an XML format) to produce the second document (which is in HTML format). This teaches away from the second document as XML because there is no need to

transform the first document (from XML to XML) merely to preserve formatting because the first document is already in XML and already has the original format which thus needs no reformatting. Indeed, applying a transformation to preserve formatting, for example, would be inefficient and not practiced by one of ordinary skill in the art to which the invention pertains at the time of the invention. Accordingly, there is no motivation or suggestion, except from the applicants' own disclosure, to make such a modification. Claim 6 is allowable.

With regard to claims 7-9, Takizawa in view of the one skilled in the art fails to overcome the deficiencies as discussed above. There is no motivation or suggestion, except from the applicants' own disclosure, to make such a modification. Claims 7-9 are allowable.

With regard to claim 12, Takizawa in view of the one skilled in the art fails to overcome the deficiencies as discussed above. There is no motivation or suggestion, except from the applicants' own disclosure, to make such a modification. Claim 12 is allowable.

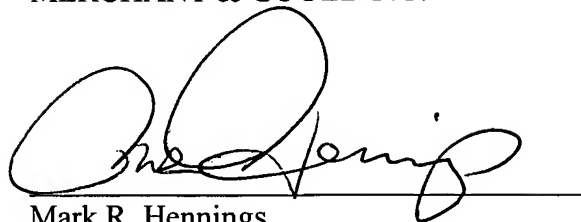
With regard to claims 16-19, Takizawa in view of the one skilled in the art fails to overcome the deficiencies as discussed above. There is no motivation or suggestion, except from the applicants' own disclosure, to make such a modification. Claims 16-19 are allowable.

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicants at the telephone number provided below.

App. No. 10/731,900
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Respectfully submitted,

MERCHANT & GOULD P.C.

A handwritten signature in black ink, appearing to read "Mark R. Hennings", is written over a horizontal line.

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